



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,783	07/23/2003	Thomas DeRossett JR.	DRV/00106	8187
24350	7590	10/26/2007	EXAMINER	
STITES & HARBISON, PLLC 400 W MARKET ST SUITE 1800 LOUISVILLE, KY 40202-3352			ELVE, MARIA ALEXANDRA	
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
10/26/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

OCT 26 2007

GROUP 1700

Application Number: 10/625,783
Filing Date: July 23, 2003
Appellant(s): DEROSETT ET AL.

Jeffrey A. Haeberlin
Stites & Harbison, PLLC
400 W. Market St.
Louisville, Kentucky 40202-3352
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/14/07 appealing from the Office action mailed 3/24/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,897,797

Drouillard et al.

4-1999

(9) Grounds of Rejection

Specification

The amendment filed 1/5/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "marking head is affixed directly to the emitter housing".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by

Drouillard et al. (US Pat. 5,897,797).

Drouillard et al. discloses a laser marking system, which etches the product surface. The marking system has a main housing (90) which has an articulated arm (94)

and conduit assembly (92) extending therefrom. A remote scanning head (50) is affixed at the end of the articulated arm. The articulated arm and conduit are a flexible link for the transfer to the laser beam between the main cabinet and the remote scanning head. The flexible conduit carries power, control cabling and an air line. At the end of the articulated arm the head input lens adjuster is provided which allows the user to vary the spot size of the laser beam on the product. Within the remote scanning head is a laser beam scanning mechanism, a rotating polygon, and a detector system, which is used to synchronize the signals for, feed back to the control electronics of the laser system. An adjustable output lens system is provided on the end of the remote scanning head, which allows the user to vary characters on the product. The computer is provided in the main housing with a keypad for inputting desired data.

The laser beam is reflected off the rotating polygon and then hits the galvo mirror, which directs the laser beam horizontally across the product. The rotating polygon only directs the laser beam in the y-axis while the galvo mirror only directs the beam in the x-axis plane. With this combination the laser beam can generate many types of marks. The closer the rotating polygon is to the galvo mirror the smaller and more focused the beam is on the product.

Additionally, the product is put into a cup type holder and a vacuum is applied in order to hold product, remove debris and ensure that the product is in close position to the laser before marking commences.

The system has a safety interlock that is a microswitch, which is mounted on a protective shield above the remote scanning head and the product.

(abstract, figures, col. 9, lines 13-57, col. 10, lines 1-5, 64-67, col. 11, lines 1-20, 48-67, col. 12, lines 1-15)

(10) Response to Argument

Before addressing the applicant's arguments, the examiner will address the new matter objection. There is no basis in applicant's specification for "directly attached". The examiner believes that it is important to highlight this because "directly attached" is discussed several times in applicant's arguments.

The following ground(s) of rejection are applicable to the appealed claims:

Applicant argues that Drouillard et al. discloses a laser marking device in which the emitter head is remote from the marking head. The examiner respectfully disagrees because the laser/emitter (28) is attached to the laser/marketing head (50) (see figure 6).

Applicant argues that in Drouillard et al. an articulated arm interconnects the remote emitter (laser) to the marking head. The examiner respectfully disagrees because the emitter (laser) (28) is attached to the laser head (50), which makes marks on the product. The articulating arm and conduit assembly (92 & 94) carried the power, control cabling and air line for the remote scanning head (50). (col. 11, lines 4-6).

Applicant argues that the two units are not pivotally attached. The examiner respectfully disagrees because the laser head (50) is connected to an articulated arm

(94) and conduit (92), which is flexible (known pivotal motion). (See figure 6, col. 10, lines 64-67 & col. 11, lines 1-2).

Applicant argues that articulated arm provides an elongated optical path with the attendant deficiencies associated with articulated arms, especially the need for constant adjustment to maintain the optical path. The examiner respectfully notes that the articulated arm and conduit have a fixed length (see figure 6) and hence adjustment is not possible. Furthermore, Drouillard et al. states that the laser beam is directed along a *predetermined* path (claims).

Applicant argues that there is no teaching of the direct attachment of the emitter housing and marking head, Drouillard et al. does not provide the elements of applicant's etching apparatus arranged as claimed by applicants. In addition, applicant argues, "Thus, even if the reference contains the same elements, it does not anticipate if they are not arranged as claimed". The examiner respectfully disagrees. The emitter housing (laser housing see element 28 in figure 6) is attached to the laser marking head (50). Applicant's etching apparatus is a marking apparatus. The examiner respectfully notes that the same elements are taught emitter/laser housing (28) and marking head (50) and they are attached and in the same order as in applicants claims.

Applicant argues that by *directly attaching* the emitter housing in which the laser source is located to the marking head, the device of the present invention provides an improved laser marking system with a short optical path that requires no adjustment. The examiner respectfully notes that applicant does not have basis in the original

specification and claims for ***directly attaching*** (see discussion above). Applicant's instant claims do not disclose a short optical path.

In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., direct attachment of the emitter housing and marking head & short optical path) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/M. Alexandra Elve/

M. Alexandra Elve

Primary Examiner 1793

Conferees:

/Jonathan Johnson/

Jonathan Johnson

SPE 1793

/Patrick Ryan/

Patrick J. Ryan

SPE 1795